

07-13-07 13:51 FROM-

Application No. 10/663,979

RECEIVED  
CENTRAL FAX CENTER

T-454 P005/017 F-073

JUL 13 2007

Art Unit: 3714

## REMARKS

This response is submitted in reply to the Office Action mailed on May 17, 2007 ("Office Action"), including amendments to Claims 29-31 and the addition of new claims 32-33. The amended claims and new claims do not add any new matter to the present application.

5 In the Office Action, the Examiner objects to Claims 29-31. Each of the Examiner's objections is discussed below, along with an appropriate reply and/or remedy.

### Rejection Under 35 USC §102 – Anticipation

The Examiner states that Claims 29 to 31 are anticipated by Benett (US 6,585,264).  
10 Applicant respectfully submits that Benett does not teach the same invention as the present application and provides no grounds for rejection, as discussed in the three (3) sections below.

#### 1. Assignment of Movement Patterns and Directions of Expansion

The Examiner's Reply dated May 14, 2007, at page 6, lines 9-11, states that "As applicant's claimed invention does not disclose how predetermined movement directions are assigned to a wildcard symbol, the manner by which the prior art assigns predetermined movement patterns is irrelevant." The Applicant respectfully submits that amended Claims 29-33 teach methods of assigning movement directions and, furthermore, these methods are unique to and apart from the methods disclosed by the Benett invention.  
15

Benett's specification teaches a game that uses board game pieces to represent the wildcard symbols, with each board game piece assigned a movement pattern in accordance with 20 the conventional board game rules. For example, a wildcard symbol represented by a bishop is assigned the diagonal movement pattern of a bishop playing piece from a conventional chess game. Specifically, Benett states that: "...whenever any chess piece substitute symbol is spun up and displayed, then after any applicable wins have been paid, the chess piece will make one

Application No. 10/663,979

Art Unit: 3714

move, ie. from its initial display position to a following display position, according to its normal chess movement pattern." (Benett, column 3, lines 40-44; emphasis added.)

The present invention, however, teaches a game in which wildcard symbols are assigned directions of expansion using the directional indicia displayed on the wildcard symbols. For example, "Up" wildcard symbols, as represented by the letter "U" (for Up), convert all of the symbol positions above the "U" symbol into additional wildcard symbols. Similarly, "Down" wildcard symbols, as represented by the letter "D" (for Down), convert all of the symbol positions below the D symbol into additional wildcard symbols. Specifically, the present application provides the following illustration of directional indicia:

For example, using the numbers 1 to 9 to represent the symbol set, with U representing the Up Wild symbol and D representing the Down Wild symbol:

Before directional wild symbols expand:

9	1	6	8	3
4	5	D	3	7
U	3	7	6	2

After directional wild symbols expand:

U	1	6	8	U
U	5	D	3	7
U	3	D	6	2

(Winning combinations in bold.)

Before expansion, each wild symbol occupies a single symbol position. After expansion, however, the U symbol in symbol position 1/3 grows upwards into symbol positions 1/2 and 1/1; and the D symbol in symbol position 3/2 grows downwards into symbol position 3/3. By using all of the U and D wild symbols, the game awards credits for the winning symbol combinations. In this example, the U and D wilds act as "3" and "5" symbols to make winning 5-5-5 and 3-3-3 combinations. (Directional Wild Application with Serial No. 10/663,979 at pages 9-10; emphasis added. Also see Directional Wild application, Figures 4a-f, along with accompanying descriptive text on pages 25-31.)

Application No. 10/663,979

Art Unit: 3714

To further emphasize the use of directional indicia to assign the direction of wildcard expansion, Applicant amends Claims 29-31 to include language stating that the wildcard symbols shall expand in the directions assigned by the directional indicia. Claim 29 has been amended to include wildcard symbols that expand "in all of the predetermined directions assigned by the directional indicia displayed on each said wildcard symbol...." The language of Claim 30 now describes how "directional indicia for a wildcard symbol assigns one or more of the following predetermined directions...." And Claim 31 states that the wildcard symbols shall expand N symbol positions "towards the predetermined direction(s) assigned by the directional indicia displayed on the wildcard symbol...." In addition, Applicant has added Claim 32 which specifies letters or words as the directional indicia and Claim 33 which specifies arrows as the directional indicia.

For the foregoing reasons, Applicant respectfully submits that the present invention's novel methods of using directional indicia to assign the direction of wildcard expansion distinguish the present invention from the Benett invention.

15

## 2. Indication of Movement Pattern or Direction of Expansion

The Applicant respectfully submits that displaying directional indicia on wildcard symbols provides the player with certain knowledge of the movement pattern assigned to the wildcard symbol prior to the execution and display of the movement pattern and, as such, serves to further distinguish the present invention from the Benett invention.

The Benett invention uses board game pieces, such as chess pieces, to indicate the pattern of movement for each symbol to the player. The use of board game pieces, however, requires knowledge of the rules of a board game, such as chess, that is unrelated to the operation of a slot

DIRECTIONAL WILDS

Page 6 of 16

MARKS ET AL

machine game and, therefore, unobvious to someone of ordinary skill in the art at the time of the invention.

Furthermore, even if a slot machine player possessed knowledge of the rules of chess or other board games, the choice between two or more movement patterns makes it impossible to accurately predict the exact movement pattern of the board game piece. For example, the board game of chess uses playing pieces which execute movement patterns in multiple directions (i.e. with as few as two (2) directions for a Pawn or as many as nine (9) directions for a Queen).

The present invention, however, clearly and unambiguously indicates the direction of wildcard symbol expansion by displaying directional indicia on that wildcard symbol. The use of letters (i.e. "U" or "D"), words (i.e. Up or Down), arrows (i.e. ↑ or ↓), other visual directional indicia makes the direction of wildcard expansion obvious to the player. For example, wildcard symbols marked with the letter "U" or the word "Up" will expand in the upwards direction.

In addition, the present invention may also show the player the exact number of symbol positions that the wildcard symbol will expand ("N") in the indicated direction of expansion. Thus, someone of ordinary skill in the art at the time of the invention could precisely determine the path of wildcard symbol expansion using the number and directional indicia displayed on that wildcard symbol. For example, wildcard symbols marked with Up-3 will expand 3 symbol positions in the upwards direction.

For the foregoing reasons, Applicant respectfully submits that the present invention's novel methods of using directional indicia to indicate the direction of wildcard expansion distinguish the present invention from the Benett invention.

**3. Method of Determining Movement Pattern or Direction of Expansion**

The Examiner's Reply dated May 14, 2007, at page 6, lines 13-15, states that "Applicant's argument that Benett does not disclose expanding a wildcard symbol in predetermined directions associated with the symbol without requiring a control means to select one of the directions of expansion (Remarks, P. 6), is not persuasive."

5

Applicant respectfully disagrees with the Examiner's conclusion and re-submits that the present invention teaches novel methods by which wildcard symbols automatically expand in all of the directions displayed by the directional indicia without requiring a control means to select one of the directions of expansion. By extension, Applicant also re-asserts that the Benett invention requires the use of a control means to determine one of multiple movement patterns available to each board game piece used in the Benett embodiments.

10

*a. Automatic Determination of Movement Pattern*

15

In concluding that Benett provides for an "automatic" determination of the movement pattern, the Examiner incorrectly relies upon the quotation from Benett at column 1, lines 57-59, which states: "The control means may be pre-programmed to make the determination so that, in effect, the determination is predetermined." (See Examiner's Reply dated May 14, 2007, page 4, lines 3-8; also see same at page 6, lines 13-20.) This statement, however, refers to the prior sentence which reads: "The control means may make a determination, at each position to which each representation of the playing piece moves, as to whether or not the playing piece is to act as a substitute for the underlying symbol." (Benett, column 1, lines 54-57; emphasis added.)

20

Thus, the statement quoted by the Examiner refers to the automatic replacement of underlying symbols with a playing piece, but does not refer to the automatic determination of one movement pattern from a choice of two or more movement patterns. It is therefore incorrect

Application No. 10/663,979

Art Unit: 3714

for the Examiner to rely upon this statement to conclude that: "...Benett contemplates an embodiment wherein no decisions as to the possibility of movement or the direction of movement are made by the processor, and pre-determined movement patterns are executed automatically." (Examiner's Reply dated May 14, 2007, page 4, lines 6-8.)

5 Moreover, the Examiner acknowledges that Benett uses a controller to determine the direction of wildcard expansion by stating: "Specifically, Benett discloses that if [sic] there is more than one possible direction of movement associated with a wildcard, then the direction of movement is selected by the controller (col. 3, lines 44-47)." (Examiner's Reply dated May 14, 2007, page 4, lines 18-20; emphasis added.) Applicant fully agrees with the Examiner's  
10 statement and proffers that the Bennet specification and claims provide ample evidence to support the Examiner's statement.

Benett's specification states that "[w]here the chess piece can move in a number of directions from its initial display position, the control means may make a determination as to the direction in which the chess piece is to move." (Benett at column 2, lines 10-14; emphasis added.) Benett provides an example from a preferred embodiment in which "...the controller 44 of the gaming machine 10 selects the direction of movement of the Bishop 50 as it does of the Rook 52. It will be appreciated that the Rook could either move vertically, only along the visible display positions of the fifth reel, or horizontally, in a line across all five reels 18 from its position in the fifth reel. Once again, the controller 44 determines in which direction the Rook  
20 will move." (Benett, column 4, lines 3 to 10; emphasis added.) Throughout the specification, Benett uses a control means to determine a particular movement pattern of a playing piece.

Benett then claims a gaming machine that "...where the chess piece can move in a number of directions from its initial display position, the control means makes a determination as

Application No. 10/663,979

Art Unit: 3714

to the direction in which the chess piece is to move.” (Bennett, column 5, lines 21 to 24; emphasis added.) Bennett also claims another variety of a gaming machine using a control means in which “the determination [in which direction to execute the movement pattern] is a random determination.” (Bennett, column 5, lines 25 to 26.) In all of the claims, Bennett uses a control  
5 means to determine a particular movement pattern of a playing piece.

Bennett, therefore, requires a control means to determine a direction in which to execute the movement pattern of a playing piece. In the preferred embodiment, Bennett uses the board game of chess in which all playing pieces may execute movement patterns in multiple directions (i.e. with as few as two (2) directions for a Pawn or as many as nine (9) directions for a Queen).  
10 With multiple movement patterns available for each chess piece, a control means must select one of these patterns.

The present invention, however, teaches methods by which wildcard symbols expand without use of a control means to determine a direction of expansion. Each wildcard symbol automatically expands in the predetermined direction assigned by directional indicia displayed  
15 on that wildcard symbol. The application includes numerous descriptions and illustrated examples of wildcard symbols expansion without a control means. (See Directional Wild application, Figures 4a-f, along with accompanying descriptive text on pages 25-31.) To further emphasize the absence of a control means, Applicant amended the Claims 28-31 in a prior communication (see Request for Continued Examination dated March 5, 2007, pages 2-3) to  
20 include language indicating the automatic nature of the expansion of the wildcard symbol in all directions associated with that wildcard symbol. Applicant retains the same automatic expansion language in the currently amended claims.

For the foregoing reasons, Applicant respectfully submits that the present invention’s

novel methods of automatically determining the direction of wildcard expansion distinguish the present invention from the Benett invention.

*b. Expansion in All Directions*

Without a control means to determine a direction of expansion, the present invention 5 automatically expands wildcard symbols in all directions assigned to the wildcard symbol. As discussed above, the Benett invention requires a control means to select a particular movement pattern for a wildcard symbol and, as such, does not contemplate the selection of all of the available movement patterns.

The Examiner agrees with the Applicant by stating that: "Benett does not specifically disclose automatically expanding wildcard symbols, if displayed in the symbol matrix, in all of the predetermined directions associated with each said wildcard symbol. (col. 3, lines 44-45)." (Examiner's Reply dated May 14, 2007, page 4, lines 16-20; emphasis added; italics omitted.) The Examiner, however, then cites Bussick (US 7,070,502 B1) as an example of an "analogous expansion slot machine game" (Examiner's Reply dated May 14, 2007, page 4, lines 21-22) in 15 which "wildcard symbols of Bussick expand in all pre-determined directions associated with the wildcard symbol." (Examiner's Reply dated May 14, 2007, page 5, lines 5-6.)

According to the Examiner, it would have been obvious to combine the teachings of Benett and Bussick to expand wildcard symbols in all predetermined directions associated with said wildcard symbols.

20 Applicant respectfully submits that Bussick is an unrelated reference to Benett and, therefore, the teachings of the two inventions cannot be combined. On one hand, the Benett invention teaches a game that uses board game pieces to represent the wildcard symbols, with each board game piece assigned a movement pattern in accordance with the conventional board

game rules. On the other hand, the Bussick invention teaches a method of award calculation, comprising:

...a method for evaluating a player's award in a game, wherein one symbol of the gaming device changes into another. Specifically, the present invention provides a new method of evaluating winning combinations of symbols when one or more of the symbols changes and a winning combination exists before the change and a new winning combination exists after the change. (Bussick, column 2, lines 34-40; emphasis added.)

Thus, Bussick teaches a two-stage method of award calculation in which the first stage issues awards prior to the change of a symbol into another symbol and the second stage issues awards following the change of a symbol into another symbol. The various embodiments of Bussick illustrate the two-stage award calculation by issuing awards before and after symbols change from non-wildcard symbols into wildcard symbols. Bussick, however, does not require that non-wildcard symbols change into wildcard symbols in accordance with any predetermined manner, such as movement patterns or directions of expansion.

Moreover, Applicant submits that Bussick does not teach any methods of assigning, indicating, or determining predetermined movement patterns of wildcard symbols or directions of wildcard expansion. In this regard, Applicant respectfully disagrees with the Examiner's interpretation of Bussick's Figures 7A and 7B as providing examples of predetermined movement patterns of wildcard symbols. Instead, Applicant points to the description of Figures 7A and 7B found in Bussick at column 8, lines 45-54, stating that:

Referring to FIGS 7A and 7B, one preferred method of the present invention is illustrated in a slot machine embodiment, wherein a preferably randomly generated wild symbol 110 on a central display device 30 replaces all the non-wild symbols on a row associated with or containing the wild symbol 110.

The wildcard symbols in Figures 7A and 7B replace all non-wildcard symbols on the same row as the wildcard symbol without regard to movement patterns or directions of

Application No. 10/663,979

Art Unit: 3714

expansion. Bussick neither refers to any specific movement patterns that move a wildcard from point A to point B nor does Bussick reference any particular directions of expansion for a wildcard symbol from its starting position. A priori, wildcard symbols cannot expand in all movement patterns or directions expansion if they are never assigned any movement pattern or direction of expansion. It is therefore incorrect for the Examiner to rely upon Bussick's Figures 5 7A and 7B, or any other figures in Bussick, to conclude that: "It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Bennett to include the [Bussick] feature wherein a wild symbol expands in all of the predetermined directions associated with said wildcard symbol..." (Examiner's Reply dated May 14, 2007, 10 page 5, lines 6-9.)

Unlike Bussick, the present invention teaches methods by which wildcard symbols expand in all directions assigned by directional indicia displayed on that wildcard symbol. The playing piece symbols described in Bussick may perform a series of movement patterns, but with only one movement pattern executed at a time. The present invention, however, contemplates a 15 wildcard symbol with multiple directional indicia resulting in simultaneous expansion of a wildcard symbol in two or more directions. The application includes numerous descriptions and illustrated examples of wildcard symbols expanding in all assigned directions. (See Directional Wild application, Figures 4a-f, along with accompanying descriptive text on pages 25-31.) To further emphasize the expansion of wildcard symbols in all assigned directions, Applicant 20 amended the Claims 28-31 in the prior communication (see Request for Continued Examination dated March 5, 2007, pages 2-3) to include the word "all" in relation to the direction of wildcard expansion. Applicant retains the same wording in the currently amended claims.

Application No. 10/663,979

Art Unit: 3714

For the foregoing reasons, Applicant respectfully submits that the present invention's novel methods of expanding wildcard symbol in all directions assigned by directional indicia displayed on that wildcard symbol distinguish the present invention from the Benett invention.

5

### Conclusion

In view of the foregoing remarks, Applicant respectfully submits that the present invention teaches novel methods of playing a slot machine game using expanding wildcard symbols and that prior art does not show or suggest the novel features recited in Claims 29-33, as currently amended. Claim 29 describes a method by which the directions of expansion are assigned to wildcard symbols using directional indicia, with said indicia displayed on the wildcard symbols. Claim 30 further specifies that the directional indicia may assign expansion in the upwards, downwards, leftwards, rightwards, and diagonal directions. Claim 31 further specifies that wildcard symbols expand a predetermined number of symbol positions in an assigned direction. Claim 32 specifies that letters or words are used to indicate the directions of expansion. Claim 33 specifies that arrows are used to indicate the directions of expansion.

If there is any matter that would delay this Application from passing to issue, the Examiner is requested to telephone the undersigned.

Applicant strongly emphasizes that anyone reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable.

Application No. 10/663,979

Art Unit: 3714

Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

5       Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present application and claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present 10 claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

15      For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn. And, for all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

20

Respectfully submitted,



Daniel M. Marks  
Inventor

25

07-13-07 13:55 FROM-

T-454 P017/017 F-073

Application No. 10/663,979

Art Unit: 3714

Date: 07/13/07

5

HIGH 5 GAMES  
1200 MacArthur Blvd  
Mahwah, NJ 07430  
Phone: (201) 825.1711  
Fax: (201) 825.1611

DIRECTIONAL WILDS

Page 16 of 16

MARKS ET AL

PAGE 17/17 \* RCVD AT 7/13/2007 2:58:10 PM [Eastern Daylight Time] \* SVR:USPTO-EFXRF-3/18 \* DNIS:2738300 \* CSID: \* DURATION (mm:ss):05:04